

REMARKS

This is in response to the Office Action mailed January 8, 2009. Claims 1, 3-5, 8-23, 25-35 and 37-46 are pending in this application. Of those, claims 3-5 and 14-22 are withdrawn from consideration. No claims have been amended, added or cancelled herein. Accordingly, no new matter is introduced.

Applicant wishes to thank the Examiner for the telephone interview with Applicant's counsel, Kelly Hwang, on January 26, 2009. During the interview, the pending §112 and §103 rejections were discussed. With respect to the §112 rejection, no agreement was reached during the discussion, and as such, Applicant provides herein a more detailed explanation as to why one of ordinary skill in the art, when reading claim 8 in light of the specification, would readily recognize the boundary set out by the claim term "hydrophobic AMPS derivatives."

With respect to the §103 rejection based on Dubief et al. (U.S. Patent 6,090,376) ("Dubief"), the undersigned noted during the discussion that *Dubief* teaches using a grafted silicone copolymer composed of an organic main chain that does not contain silicone, grafted with at least one polysiloxane monomer. In contrast, claims of the present application recite a grafted silicone copolymer composed of a main silicone chain, grafted by at least one silicone-free organic group. The Examiner then asked whether the term "main chain" in the claims of the present application is the same as the term "skeleton" mentioned in *Dubief*. The undersigned pointed out that those two terms are synonymous as they were interchangeably used in *Dubief* and referred to all of the relevant passages in *Dubief*. After consideration and discussion, the Examiner indicated that if that is indeed the case, then the outstanding rejection based on *Dubief* is likely to be withdrawn, and requested that Applicant

provide all of the relevant passages in a written response for the Examiner's further review and analysis.

In view of the remarks made herein, Applicant respectfully requests reconsideration of the rejections and allowance of all pending claims.

**Rejection based on 35 U.S.C. § 112**

The Examiner has rejected claims 8-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that the claim term "hydrophobic AMPS derivatives" is not clearly defined in the specification. Applicant respectfully traverses the rejection.

The specification has a section entitled "Hydrophobic AMPS derivatives" on pages 11-14, providing a description of the claim term "hydrophobic AMPS derivatives." Specifically, in [0058] on page 13, it is clearly disclosed that the preferred polymers of the hydrophobic AMPS derivatives are chosen from crosslinked or non-crosslinked amphiphilic polymers of (a) 2-acrylamido-2-methylpropanesulphonic (AMPS) acid and (b) at least one ethylenically unsaturated monomer comprising at least one hydrophobic portion containing from 6 to 30 carbon atoms. More specifically, in [0059] on pages 13-14, the specification discloses, as an example, particular hydrophobic AMPS derivatives, which are copolymers consisting of (a) a specific AMPS of formula (IV) and (b) at least one ethylenically unsaturated monomer comprising at least one hydrophobic portion of formula (V). Based on such disclosure, one of skill in the art would not find the claim term "hydrophobic AMPS derivatives" unclear or indefinite in any way.

During the telephonic interview of January 26, 2009, the Examiner contended that such disclosure can be interpreted

to mean that hydrophobic AMPS derivatives are either (1) crosslinked or non-crosslinked amphiphilic polymers of AMPS or (2) crosslinked or non-crosslinked amphiphilic polymers of at least one ethylenically unsaturated monomer comprising at least one hydrophobic portion. However, Applicant respectfully submits that this is a technical argument based on an incorrect application of English grammar. The specification clearly uses the term "and", which is a conjunction, and not "or", which is a disjunction. Based on such disclosure, one skilled in the art would not read the disclosure as the Examiner contended.

In light of the foregoing, it is submitted that one of ordinary skill in the art, when reading claim 8 in light of the specification, would readily recognize boundary set out by the claim term "hydrophobic AMPS derivatives." Accordingly, withdrawal of the rejection is requested.

Rejection based on 35 U.S.C. § 103

The Examiner has rejected claims 1, 8-15, 23, 25-35 and 37-42 as being unpatentable over *Dubief*. In the Office Action, the Examiner contended that (1) claims of the present application require a "grafted silicone having a main silicone chain"; (2) *Dubief*'s grafted silicone polymer is composed of a non-silicone skeleton, but has silicone in the main chain; and (3) since the claims of the present application do not recite that "skeleton of the grafted polymer is silicone," the pending claims are obvious over *Dubief*. (See page 5 of the Office Action.)

Then, during the telephonic interview of January 26, 2009, the Examiner asked whether the term "main chain" in the claims of the pending application is the same as the term "skeleton" mentioned in *Dubief*. The undersigned pointed out

that those two terms are synonymous as they were interchangeably used in *Dubief*.

All of the relevant passages in *Dubief* are as follows:

The silicone polymers in accordance with the present invention are preferably composed of **an organic main chain formed from organic monomers not containing silicone**, on which is grafted . .

The **non-silicone organic monomers constituting the main chain** of the grafted silicone polymer can be chosen from monomers with ethylenic unsaturation polymerizable by the radical route, monomers polymerizable by polycondensation, such as those forming polyamides, polyesters or polyurethanes, or monomers with ring opening, such as those of the oxazoline or caprolactone type.

(*Dubief*, col.2 ll.16-26) (emphasis added.)

1. A cosmetic or dermatological composition for the treatment of a keratinous substance, comprising, in a cosmetically or dermatologically acceptable medium,

at least one grafted silicone polymer with a **non-silicone organic skeleton** grafted by at least one polysiloxane monomer, and

at least one ionic amphiphilic polymer comprising at least one fatty chain and at least one hydrophilic unit, with the exception of crosslinked copolymers of acrylic acid and C<sub>10</sub>-C<sub>30</sub> alkyl acrylates.

(*Dubief*, col.9 ll.52-63) (emphasis added.)

Another specific family of silicone polymers suitable for the implementation of the present invention is composed of the grafted silicone copolymers capable of being obtained by reactive extrusion of a polysiloxane macromer having an end reactive functional group with a polymer of the polyolefin type containing reactive groups capable of reacting with the end reactive functional group of the polysiloxane macromer in order to form a covalent bond enabling the

silicone to be grafted to the main chain of the  
polyolefin.

(*Dubief*, col.4 ll.46-54) (emphasis added.)

14. A composition according to claim 1, wherein said at least one grafted silicone polymer is a copolymer obtained by reactive extrusion of a polysiloxane(sic) monomer, said polysiloxane monomer being a polysiloxane macromer having an end reactive functional group, with a non-silicone organic skeleton, said non-silicone organic skeleton being a polyolefin containing reactive groups capable of reacting with the end reactive functional group of the polysiloxane macromer to form a covalent bond enabling said polysiloxane macromer to be grafted to the polyolefin.

(*Dubief*, col.12 ll. 17-26) (emphasis added.)

Based on the teachings in *Dubief* as shown above, it is clear that the silicone polymers of *Dubief* are composed of an organic main chain formed from organic monomers not containing silicone. In contrast, claims of the present application recite grafted silicone polymers having a main silicone chain.

Accordingly, *Dubief* not only fails to disclose all of the elements as claimed in the pending application, but also fails to provide any rationale to arrive at the claimed invention without destroying the operability of the cited reference. As such, Applicant respectfully requests that this rejection be withdrawn.

The Examiner has rejected claims 1 and 43-46 as being unpatentable over *Dubief* in view of *Daiko et al.* (U.S. Patent 6,846,812) ("*Daiko*"). The Examiner has alleged that although *Dubief* does not teach using the composition containing a grafted silicone polymer to treat/smooth wrinkled skin or restore skin tautness, the secondary reference, *Daiko*, discloses that grafted silicone has the capability of fading out irregularities in the

skin such as wrinkles and fine lines. Therefore, the Examiner has concluded that it would have been obvious to one of ordinary skill in the art to apply the composition of *Dubief* to the skin as taught in *Daiko*. Applicant respectfully traverses.

*Daiko* focuses on the novel 7-oxo-DHEA derivative and does not teach grafted polymers having a main silicone chain. Therefore, the secondary reference, *Daiko*, does not remedy the deficiencies in *Dubief*. As such, Applicant respectfully requests withdrawal of the rejection.

**Provisional Double Patenting Rejection**

Claims 1, 2, 6-13, 23, 25-35 and 37-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 and 1-16 and 19-21 of copending application nos. 10/982,925 and 10/508,007, respectively. In addition, claims 1, 2, 6-13, 23, 25-35 and 37-46 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 60-116 and 1-59 of copending application nos. 10/591,583 and 10/573,579, respectively.

Since the rejection is provisional, Applicant requests that the rejection be held in abeyance until the provisional obviousness double patenting is the only rejection remaining in this application or the claims of co-pending applications are allowed.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 8, 2009

Respectfully submitted,

By \_\_\_\_\_

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